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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,156	10/17/2001	Adrienne Lewis	1248-R-01	5615

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IP DEPARTMENT OF PIPER RUDNICK LLP
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EXAMINER

MYHRE, JAMES W

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 12/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/981,156

Applicant(s)
Lewis

Examiner
James W. Myhre

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Oct 24, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 24, 2003 has been entered.

Response to Amendment

2. Per the Applicant's request, the after-final amendment filed on September 25, 2003 amending Claims 1, 8, 18, 25, and 32-36 has been entered and considered but is ineffective to overcome the Von Kohorn (5,916,024) reference. Claims 1-41 are currently pending in this application.

Claim Objections

3. The amendment filed on September 25, 2003 has corrected the minor deficiencies in Claims 33-36 as objected to in paragraph 3 of paper number 12. Therefore, the Examiner hereby withdraws those objections.

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Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Von Kohorn (5,916,024).

Claims 1, 8, 13, 18, 25, and 32: Von Kohorn discloses a system, method, and computer program for advertising on a computer network, comprising:

- a. Presenting an initial advertisement relating to a specific product or service;
- b. Prompting a player to access the advertisement by selecting an icon or link;
- c. Incorporating one or more additional advertisements into an interactive game;
- d. Allowing the player to play the game based on the player's interaction with the initial advertisement (col 1, line 25 - col 10, line 43).

The Examiner notes that Von Kohorn discloses that a plurality of products (i.e. advertisements) are presented to the user, who selects one of the products (col 79, lines 35-41) "by touching numbered buttons...or by other means" (col 85, lines 31-32) and is then directed to the game in order to "win" or qualify for some type of incentive for the selected product, such as a discount, coupon, free merchandise, etc. Since the product is selected prior to the user

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beginning to play the interactive game, the Examiner considers this to be the equivalent of the “initial advertisement” in the amended claims. Von Kohorn further discloses that the user is presented with information about the nature of the game (i.e. an advertisement to entice the user to play the game) prior to entering, such as the time when the game may start (col 92, lines 14-26), thus, again discloses an “initial advertisement”. Von Kohorn also discloses that the game can consist of one or more additional advertisements being displayed to the user, who then responds to one or more queries about advertisement(s) in order to win the game.

The Examiner notes that the disclosure that the user may make a selection through the response device by touching numbered button or by other means would encompass other known input means, such as a mouse, track ball, joystick, touch screen, etc. The presentation of additional information about the product or service to the user when a selection is made implies that the selection is “linked” to the additional information files.

Claims 2, 9, 19, and 26: Von Kohorn discloses a system, method, and computer program for advertising on a computer network as in Claims 1, 8, 18, and 25 above, and further discloses that the additional advertisement is an active element of the game (col 1, line 25 - col 10, line 43 and col 47, lines 11-15).

Claims 3, 10, 20, 27, and 34: Von Kohorn discloses a system, method, and computer program for advertising on a computer network as in Claims 1, 8, 18, 26 and 32 above, and further discloses that the game is a trivia game and that the additional advertisement provides

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clues to the trivia questions (col 1, line 25 - col 10, line 43; col 43, lines 1-15; and col 119, lines 4-8).

Claims 4, 11, 21, and 28: Von Kohorn discloses a system, method, and computer program for advertising on a computer network as in Claims 1, 8, 18, and 27 above, and further discloses prompting the player to access advertisements on the advertiser's website in order to progress in the game (col 1, line 25 - col 10, line 43).

Claims 5, 12, 22, 29, and 35: Von Kohorn discloses a system, method, and computer program for advertising on a computer network as in Claims 1, 8, 18, 28, and 32 above, and further discloses providing one or more prizes to winning players (col 1, line 25 - col 10, line 43).

Claims 6, 14, 15, 23, 30, and 36: Von Kohorn discloses a system, method, and computer program for advertising on a computer network as in Claims 1, 8, 13, 18, 29, and 32 above, and further discloses compiling demographic information on the player and targeting the advertisement based on the player's demographic information (col 1, line 25 - col 10, line 43).

Claims 7, 16, 24, 31, and 33: Von Kohorn discloses a system, method, and computer program for advertising on a computer network as in Claims 1, 8, 18, 30, and 32 above, and further discloses that the game is one of a trivia game, bingo, dominoes, casino games, card games, tic-tac-toe, or jigsaw puzzle (col 1, line 25 - col 10, line 43 and col 119, lines 4-8).

Claim 17: Von Kohorn discloses a method for advertising on a computer network as in Claim 8 above, and further discloses placing the game into a computer advertising spot (col 1, line 25 - col 10, line 43).

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Claims 37-40: Von Kohorn discloses a system, method, and computer program for advertising on a computer network as in Claims 1, 8, 18, and 25 above, and further discloses that the initial advertisement is accessible independent of accessing an advertiser's website. Von Kohorn explicitly discloses that the advertisements may be downloaded to the user's remote device prior to the user accessing the advertisement or game program. This downloading may be from online or through the use of a memory disk distributed to the user (col 29, lines 27-34; col 79, line 62 - col 80, line 7; and col 140, lines 59-67). Thus, when the user begins, an initial advertisement is presented to the user without necessitating the user connecting to the advertiser's website.

Claim 41: Von Kohorn discloses a method for advertising on a computer network as in Claim 4 above, and further discloses that the advertising material is one of images of products, marketing messages, logos, taglines, and jingles (col 18, lines 23-29 and col 47, lines 9-19).

Response to Arguments

6. Applicant's arguments filed June 30, 2003 have been fully considered but they are not persuasive.

As discussed in the rejection of the amended claims above, Von Kohorn discloses presenting an initial advertising message to the user prior to the start of the interactive game. Since the user must select the desired product before the game play begins, the user's selection is a prerequisite for playing the interactive game. In the other cited section, Von Kohorn discloses

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that prior to the user participating in the game additional information pertaining to the game, such as the time when the game will start, is presented to the user. In other words, the game and its start time is advertised to prospective participants, who may then choose to access and participate in the game at the advertised time.

Von Kohorn also discloses that the player selects a desired product (or product area of interest) which will be awarded as the prize for playing/winning the game by correctly answering the questions (col 86, lines 1-20 and col 90, lines 56 - col 91, line 31). It is also disclosed that the game may consist of presenting advertisements to the player, and then posing questions about the advertised product, with a correct answer qualifying the player for a prize (such as a coupon for the selected/advertised product)(col 47, lines 1-18).

The Applicant describes the Von Kohorn invention as being “akin to two people in different locations using walkie-talkies to conduct a question and answer session” (page 11) and then argues that this is not “interactive”. The Examiner notes that two people receiving and sending messages to each other using walkie-talkies in a prime example of an interactive system in that both people are interacting (reacting) and responding to the information being received from the other. Furthermore, while the Von Kohorn invention is practiced preferably in a television environment, it is also disclosed that the invention could be practiced “via computers linked for communication by a network” and that the “games may be played on home computers with the aid of game material provided by on-line operation with computers of the central station” (col 9, lines 51-64). Thus, an interactive game presented over a computer network is explicitly disclosed.

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Conclusion

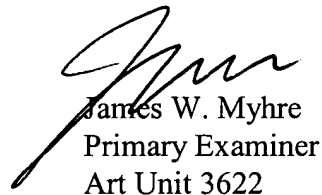
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9306. Draft or Informal faxes may be submitted to (703) 872-9327 or directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.


JWM

December 18, 2003


James W. Myhre
Primary Examiner
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